

REMARKS

Claims 1-3, 5, 6, 8, 9, 17 and 19-21 are pending in this application. Claims 1, 17 and 19 have been amended. Claims 1 and 17 are independent claims.

In an Office action mailed April 13, 2004, the pending claims were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Bentley et al. (hereinafter, "Bentley"). Applicants note with appreciation that while Applicants' previously filed remarks with regard to claim 1 and its dependent claims were considered to be moot in view of a new grounds of rejection, the remarks regarding claim 17 were addressed in the section of the Office action entitled "Response to Arguments." The explanation within that section provides a better understanding of the reasoning in applying the Bentley teachings to the description in the claims.

In view of the increased understanding of the rejection based upon Bentley, claims 1, 17 and 19 have been amended. Previously, it was Applicants' position that the step of "enabling a second processor" located within a computer would be readily understood by a person of ordinary skill in the art to include placing the computer in a "powered-on state" since a processor is not enabled if it is without power. Following this enablement step, the separate step of determining whether to process the call-related data using the first or second processor should not include determining whether the computer is in a "powered-on state." Nevertheless, claim 17 has been amended to state that the "recognizing" step (which necessarily precedes the "determining" step) includes recognizing that both the first processor and the second processor are currently available to execute the "further processing." Additionally, claims 1, 17 and 19 have also been amended to more clearly define the invention as one in which the "processing" of the call-related data is not redundant with the "storing" of the call-related data.

The amendments were not previously submitted, since the two claimed determinations that occur within the telephone were viewed by Applicants to be separate determinations, rather than redundant determinations. Claims 1 and 19 have been amended to more clearly provide that the

two “determining” steps are not redundant. Specifically, the determination regarding storage in alternative memories is not the same as the determination regarding processing by alternative processors.

Claim 1 has also been amended to note that recognizing that the call-related data is to be processed in order to provide a particular telephone function is with respect to continued handling of at least one current call and that the call-related data will be processed, during the at least one current call.

Support for the amendments may be found in various portions of the application as originally filed. For example, on page 4, lines 6-24, all of the amendments are supported. The alternative processing capability is identified as “another embodiment” from the alternative storage capability, supporting the separation of the storage-related steps from the processing-related steps. There is support for applying the alternative processing for continued handling of at least one current call, since the stated example relates to allowing a caller to select among a variety of operations. Stated examples of extended processing capability include automatic call distribution (ACD), voice-activated functions, and/or security functions such as voice pattern recognition. Particularly with an ACD capability, the telephone function is provided for handling of at least one current call.

The amendments to the claims are intended to more clearly define the storage-related steps as being separate from the processing-related steps, so that the claims are in a better condition for consideration. Applicants respectfully request that the amendments to the claims be entered.

A. Patentability of Independent Claim 1 and Dependent Claim 19

In claim 1, the step of “determining whether the call-related data will be processed by the first or second processor” includes at least partially basing the determination upon whether the telephone has the processing capability to provide the particular telephone function. With regard to this claimed feature, the Office action cites Bentley, column 18, lines 23-28 to teach that when the maximum number of entries is exceeded, the oldest

entry for redialing is deleted. The cited portion of column 18 states that the telephone system may be limited to storing five call entries in the Redial Stack, so that if a sixth number is to be entered, the oldest entry is automatically deleted to make room for a new entry. Applicants respectfully point out that this does not anticipate the claimed basis for determining whether the first or second processor will provide the processing, since the entry is deleted. That is, rather than teaching that exceeding the maximum number of entries in the Redial Stack is used as the basis for determining whether a processor of a computer should be employed, lines 23-28 of column 18 refer merely to deleting oldest entries. Teachings regarding the Redial Stack must be considered separately from teachings regarding the Caller ID log overflow. Thus, the description regarding the Redial Stack does not present a *prima facie* case of anticipation under Section 102(b).

Moreover, claim 1 states that the determination is at least partially based upon whether the telephone has the processing capability to provide the particular telephone function. The description regarding the Redial Stack clearly sets forth the ability of the telephone to provide the particular telephone function of automated redialing. At any given time, five entries may be stored within the Redial Stack.

In addition to citing column 18, lines 23-28, the Office action cites column 4, lines 21-29 and column 27, lines 8-17, for anticipating the step of determining whether the call-related data will be processed by the first or second processors. Column 4 states that information can be uploaded to or downloaded from the personal computer. As correctly noted in the Office action, column 27 teaches that if the personal computer is "on" and the level of information stored in the telephone exceeds a predetermined level (e.g., fifty percent of its memory capacity), Caller ID information may be transferred to the computer. The log of Caller ID information is not identical to the above-referenced Redial Stack, but also has its limitations on storage capacity. Thus, Bentley describes the selective transfer of information to the computer. Column 4, lines 21-29 refer to the retransfer of information from the computer to the telephone.

Within claim 1, the “determining” step with regard to the processing follows the step of “recognizing” that the call-related data received at the telephone is to be processed in order to provide a particular telephone function. Applicants assert firstly that a person of ordinary skill in the art would not reasonably interpret the phrase “processed in order to provide a particular telephone function” as including mere storage. That is, the Caller ID information of Bentley is not information that is being processed. Moreover, since independent claim 1 and dependent claim 19 include references to determining storage and determining processing, with each determination involving enabling and recognizing steps, the person of ordinary skill in the art would not interpret “processing” to be identical to “storing.” Since the “processing” of claim 1 is not the “storing” of Bentley, Applicants submit that the “processing” must be the transfer of the Caller ID information between the telephone and the computer, if claims 1 and 19 are anticipated under Section 102(b). However, claim 1 states that the telephone controls the call-related data with respect to which of the two structurally separate components will perform the processing thereon. Because the transfer of information between the telephone and the computer necessarily is performed by both of the structurally separate components, the transfer function of Bentley does not read on the “processing” referred to in the pending claims.

To reiterate:

- (1) Since claims 1 and 19 describe storage-specific steps, the processing-specific steps of the pending claims must be considered as involving more than mere storage;
- (2) Since the transfer of Caller ID information between a telephone and computer necessarily requires performance by both the receiving component and the sending component, the decision to transfer as taught by Bentley does not anticipate the use of a telephone to determine control of call-related data with respect to which of two structurally separate components will perform processing thereon; and
- (3) Since claims 1 and 19 have been amended to state that the step of determining processing by the first or second processor is unrelated

to the step of storing the call-related data, the teachings of Bentley regarding transferring and storing do not anticipate the amended claims.

Reconsideration of claims 1 and 19 is respectfully requested.

B. Patentability of Independent Claim 17

Prior to amendment, the method of claim 17 included the step of recognizing that the call-related data requires further processing. If so, the automated processing capabilities of the telephone are used to determine whether the call-related data will be processed in the first processor of the telephone or the second processor of the computer. Finally, the call-related data is processed in either the telephone or the computer based on the determination made by the automated processing capabilities of the telephone. With regard to the sequence of these three steps, the Office action notes that Bentley teaches recognizing that a threshold of fifty percent capacity has been reached and “if memory on the telephone is greater than fifty percent full, then transfer.”

Applicants respectfully point out that the transfer that is identified as the “further processing” necessarily requires operations by both the telephone and the computer. Therefore, the cited sequence of Bentley’s steps does not result in the processing of the call-related data at either the telephone or the computer on the basis of identifying that the fifty percent capacity has been reached. Consequently, the prior art patent does not anticipate the method described in claim 17.

By amendment, claim 17 states that the determination using automated processing capabilities of the telephone includes basing the determination upon current capabilities of the telephone and computer other than storage capabilities. This distinguishes the basis of determination from that of claim 19, wherein storage is the issue. With the same reasoning, the amendment to claim 17 also distinguishes the invention from the teachings of Bentley. It is respectfully asserted that the claim and its dependent claims are in an allowable condition.

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call the undersigned.

Date: June 14, 2004

Respectfully requested,

SIEMENS CORPORATION
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830
ATTENTION: Elsa Keller, IP Department
Telephone: (732) 321-3026

By: Thomas George
Thomas George
Registration No. 45,740
Attorney for Applicants
Tel: 650-694-5191
Fax: 650-968-4517